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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,756	03/08/2002	Junichi Ikeda	112176	2862
25944	7590	09/22/2004	EXAMINER	
OLIFF & BERRIDGE, PLC			CHANG, VICTOR S	
P.O. BOX 19928			ART UNIT	
ALEXANDRIA, VA 22320			PAPER NUMBER	

1771

DATE MAILED: 09/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/092,756	IKEDA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Victor S Chang	1771	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 June 2004 and 02 July 2004.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 2 and 4-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2 and 4-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 6/24/2004, and supplemental remarks filed on 7/2/2004. Applicants' amendments to the specification, claims 2, 4 and 6-8, and cancellation of claims 1 and 12-14 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' remarks clarified the scope and meaning of the term "cured" by pointing out pertinent sections (Example 2) in the specification (Remarks, pages 8-10). As such, the rejections in sections 4 and 6 of Office action dated 3/26/2004 are withdrawn.

### ***Information Disclosure Statement***

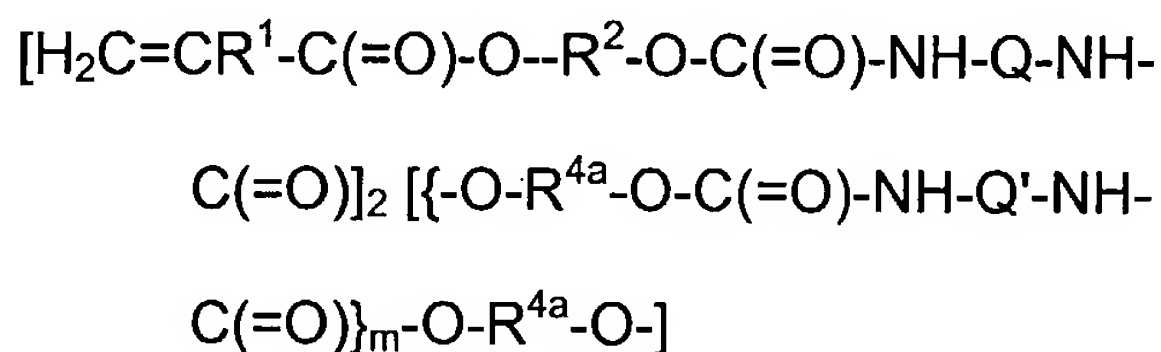
4. The listing of reference WO 01/16244 in the remarks filed on 6/24/2004 and 7/2/2004 is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office. Therefore, the reference WO 01/16244 has not been considered. The Examiner suggests that Applicants file a proper PTO-1449 for reference which needs to be considered.

***Rejections Based on Prior Art***

5. Claims 2 and 4-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ansell et al. (US 5087686) in view of Huver et al. (US 5700891).

Ansell's invention is directed to a radiation curable composition for an adhesive includes a polyurethane, for example a polyurethane comprising residues of a polyether diol or a polyester diol, capped with residues of a hydroxyalkyl acrylate or methacrylate and non-polymerizable residues of a primary or secondary alcohol (i.e., curable polyurethane oligomers capped with acrylates and alcohols). The compositions may be cured to form a pressure sensitive adhesive, and can be employed to produce adhesive dressings by coating a suitable substrate with the composition and thereafter curing the coated composition by, for example, electron beam or ultra violet irradiation (Abstract).

For claims 2, 4 and 6, Ansell lacks explicit teachings of the molecular structures of the curable polyurethane oligomers capped with acrylates and alcohols. However, it is noted that Huver's invention is directed to a composition for adhesive application, and the composition comprises an activator system for free-radical polymerizations and a free-radical polymerizable compound of the general formula:



wherein

m is from 0 to 10;

R<sup>1</sup> is hydrogen or a methyl group;

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$R^2$  is a linear or branched chain alkyl group containing from 2 to 6 carbon atoms or an alkylene oxide containing from 4 to 21 carbon atoms;

Q and Q' independently are aromatic, aliphatic or cycloaliphatic groups containing from 6 to 18 carbon atoms which are derived from the basic diisocyanate or diisocyanate mixtures; and

$R^{4a}$  is derived from a polyesterdiol having a C:O ratio of  $>2.6$ , a C:H ratio of  $<10$ , and a molecular weight of from 1000 to 20,000; and an activator system for free-radical polymerization of said compound (Abstract and column 16, line 66 to column 17, line 21).

Huwer also teaches that the composition can be prepared according to per se known prior art methods by first reacting an acrylate ( $R^1=H$ ) or methacrylate ( $R^1=CH_3$ ) containing hydroxy groups in the ester group with compounds containing isocyanate groups to form urethane groups (column 3, lines 19-23).

Specifically, the Examiner notes that Huwer's  $H_2C=CR^1-C(=O)-O-$  reads on instantly claimed  $A-O-$  and  $-O-E$ ; Q and Q' reads on  $-B-$ ;  $R^{4a}$  reads on polyester polyol;  $R^2$  reads on  $-O-D-O-$ ; and  $-O-R^{4a}-O-$  reads on the polyester element of  $-O-C_pH_q-(O-COC_rH_s-CO-O-C_pH_q)_t-O-$  in view of the molecular weight being in the range from 1000 to 20,000, as set forth above.

As such, the Examiner notes that Huwer teaches the curable polyurethane oligomers capped with acrylates and alcohols (urethane prepolymers) as claimed, and it would have been obvious to one of ordinary skill in the art to make Ansell's pressure sensitive adhesive article based on Huwer's composition of curable polyurethane

oligomers capped with acrylates and alcohols. It should be noted that the selection of a known material based on its suitability for its intended use supported a *prima facie* obviousness determination. See MPEP § 2144.07.

With respect to the product-by-process limitation in claim 5, the Examiner notes that Applicant must show that the resultant article is patentably distinct from those taught by the reference, since the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, this limitation at the present time has not been given patentable weight.

For claim 7, Ansell is silent about the hardness of the cured pressure sensitive adhesive. However, since Ansell teaches the same subject matter (cured pressure sensitive adhesive) as the instant invention, it is the Examiner's position that a suitable hardness of the cured adhesive is either anticipated, or an obvious optimization to one of ordinary skill in the art of pressure sensitive adhesive, motivated by the desire to obtain a required pressure sensitive adhesive article. It should be noted that where the claimed and prior art products are shown to be identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01. As to the thickness of the adhesive layer, it is noted that in Example 15, Ansell teaches an adhesive layer of 1 mm thick.

For claim 8, Ansell teaches that suitable backing layers are films of polyesters, etc. (column 6, line 9).

For claim 9, Ansell teaches that suitable backing layers include thermoplastic elastomers (column 6, line 26-27).

For claim 10, Ansell teaches that suitable backing layers include microporous film layers (column 6, line 2).

For claim 11, Ansell lacks an express teaching about the tensile strength of the backing layer. However, in view of the wide selections of backing layers taught by Ansell (column 5, line 45 to column 7, line 34), and also Ansell teaches the same subject matter as instant invention (cured pressure sensitive adhesive), it is the Examiner's position that a suitable tensile strength of the backing layer is either anticipated, or an obvious optimization to one of ordinary skill in the art of pressure sensitive adhesive, motivated by the desire to obtain a required tensile strength for the pressure sensitive adhesive article.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

*VSC*

Victor S Chang  
Examiner  
Art Unit 1771

9/16/2004



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